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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,580	06/12/2001	Naosumi Tada	DKT00126	4790

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FITCH EVEN TABIN AND FLANNERY  
120 SOUTH LA SALLE STREET  
SUITE 1600  
CHICAGO, IL 60603-3406

EXAMINER

STEFANON, JUSTIN

ART UNIT	PAPER NUMBER
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3682

DATE MAILED: 09/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/879,580

Applicant(s)

TADA, NAOSUMI

Examiner

Justin Stefanon

Art Unit

3682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 2-4, 7-12 and 15-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 6, 13 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Group II, Figure 2, in Paper No. 8 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 2-4, 7-12, and 15-18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 8.

### ***Oath/Declaration***

3. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: The filing date for the foreign application on which priority is claimed does not match the filing date specified in the declaration.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1, 5, 6, 13, and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 1 recites "a friction surface disposed between the second blade shoe portion and the sliding face". However, the friction surface of the elected embodiment is not between the two, but within the sliding face. The second blade shoe portion must either slide on the sliding face or on the friction surface, as claimed it does both. Therefore, the claim is inaccurate.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 5, 6, 13, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 5,462,493 to Simpson.

Simpson discloses a blade tensioner with a base 146 having a sliding face, the upper surface of the base, a shoe 120, pivotally supported by the base, having a first chain sliding face 123, an opposing second face 128, and a second blade shoe portion 110 freely slidable on the base sliding face, a plurality of blade springs 133,134 disposed on the second face of the blade shoe, and a friction surface, the surface of the sliding face of base 146, which inherently provides a coefficient of friction effective to damp vibrations of the tensioner. The shoes are plastic, so the friction surface is configured using plastic.

In reference to claim 5, the friction surface is on the sliding face of the base. The prior art discloses the basic product as cited in the claims. Even though product-by-

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process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. See MPEP § 2113.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 5, 6, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5,425,680 to Young in view of US Pat. No. 5,984,815 to Baddaria and US Pat. No. 5,045,031 to Thomey.

Young discloses a blade tensioner with a base 46 having a sliding face, a blade shoe 26, pivotally supported by the base, having a first chain sliding face, an opposing second face, and a second blade shoe portion 30 freely slidable on the base sliding face, a blade spring 38 disposed on the second face of the blade shoe, and a friction surface, the surface of the sliding face of base, which inherently provides a coefficient of friction effective to damp vibrations of the tensioner. However, Young does not disclose a plurality of blade springs, merely one. Baddaria discloses the use of a plurality of blade springs 15 in a blade tensioner 10. It would have been obvious to one skilled in the art at the time the invention was made to provide the tensioner of Young with the blade shoe of Baddaria, as it is a similar type to the one used by Young, and Baddaria teaches, in column 1 lines 17-19, that it is known in the art to use one or more blade

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springs in such a tensioner. Young also does not teach a friction surface disposed between the second blade shoe portion and the sliding face of the base. Thomey discloses a belt tensioner with a base having a sliding face 62, a blade shoe 56 in contact with the belt and slidable on the sliding face, and a friction surface 64 disposed between the blade shoe and the sliding face of the base. Thomey discloses the friction surface may be disposed on the sliding face 62 of the base in column 2, lines 45-48. Thomey discloses the friction surface is plastic. It would have been obvious to one skilled in the art at the time the invention was made to provide the tensioner of Young with the friction surface of Thomey, as Thomey teaches such a pad may be used in a damping apparatus in a belt tensioner to provide separate friction characteristics to the material used for the shoe, such as by the use of Delrin as disclosed in Column 4, lines 59-63, which has a lower static coefficient of friction than its dynamic coefficient of friction.

In reference to claim 5, the friction surface of Thomey is on the sliding face of the base. The prior art discloses the basic product as cited in the claims. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. See MPEP § 2113.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art shows several types of belt tensioner utilizing a friction surface to dampen vibrations in the belt, including:

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7. US Pat. Nos.: 5,045,031 to Thomey; 5,286,234 to Young; 5,318,482 to Sato et al.; 5,425,680 to Young; 5,462,493 to Simpson; 5,797,818 to Young; 5,984,815 to Baddaria; 6,238,311 to Cutting; 6,364,796 to Nakamura; and 3,276,282 to Duncan.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin Stefanon whose telephone number is 703-305-1945. The examiner can normally be reached on Monday - Friday 6 - 3:30, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Bucci can be reached on 703-308-3668. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

js  
September 9, 2002

  
CHONG H. KIM  
PRIMARY EXAMINER